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OFFICE OF PETITIONS

In re Application of	:	DECISION ON APPLICATION
ALITALO et al.	:	FOR PATENT TERM ADJUSTMENT
Application No. 10/567,630	:	
Filed: May 30, 2006	:	
Atty Docket No. 28113/39467A	:	

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT RECALCULATION UNDER 37 C.F.R. § 1.705(b)" filed August 16, 2011. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from 43 days to 883 days.

The request reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance is **DISMISSED**.

In the present petition, applicants dispute the period of adjustment of 169 days pursuant to 37 CFR 1.702(a)(1) for the Office's failure to mail at least one of a notification under 35 U.S.C. 132 not later than fourteen months after the date on which the application fulfilled the requirements of 35 U.S.C. 371. Applicants contend that the Office incorrectly calculated the period of adjustment beginning on July 31, 2007, the day after the date that is fourteen months after the date on which the application fulfilled the requirements of 35 U.S.C. 371, and ending on January 15, 2008, the date of mailing of a Restriction Requirement. Applicants argue that "[n]either this restriction requirement, nor three more that followed it, are the proper 'first action' for purposes of calculating PTA that accrued under 37 CFR 1.702(a)(1)." *Petition, p. 3.* Applicants assert that "[t]he prosecution history demonstrates that the Office issued four improper restriction requirements (from January 15,

2008 to July 31, 2009), that were vacated." *Id.* Applicants state that the first Office action was not mailed until January 21, 2010. Applicants contend that the period of adjustment pursuant to 37 CFR 1.702(a)(1) should be 906 days, calculating the days in the period beginning on July 31, 2007, the day after the date that is fourteen months after the date on which the application fulfilled the requirements of 35 U.S.C. 371, and ending on January 21, 2010, the date of mailing of the non-final Office action.

Furthermore, applicants dispute the determination of Applicant delay as 163 days. Applicants argue:

> [O]nly 60 of those days were properly chargeable to the Applicants (48 days ending 12-00-2010; and 12 days ending 05-03-2010). The other 103 days charged against the Applicants all related to the vacated Office actions. Because those actions have been vacated for purposes of PTA, it was not proper to charge the Applicants with the 30 + 42 + 31 days of delay set forth in the Office's preliminary calculation. Applicants should not be charged with delay in responding to vacated (void) Office actions.

Petition, p. 4.

Applicants' arguments have been considered but are not persuasive.

The vacatur of an Office action sets aside or withdraws any rejection, objection or requirement in an Office action, as well as the requirement that the applicant timely reply to the Office action to avoid abandonment under 35 U.S.C. § 133. The vacatur of an Office action signifies that the Office action has been set aside, voided, or withdrawn as of the date of the vacating Office action or notice. The vacatur of an Office action, however, does **not** signify that the vacated Office action is void *ab initio* and is to be treated as if the USPTO had never issued the Office action. The patent examination process provided for in 35 U.S.C. §§ 131 and 132 contemplates that Office actions containing rejections, objections or requirements will be issued, and that the applicant will respond to these Office action, "with or without amendment." (35 U.S.C. § 132(a)). The mere fact that an examiner or other USPTO employee upon further

reflection determines that an Office action, or that a rejection, objection or requirement in an Office action, is not correct and must be removed does not warrant treating the Office action as void *ab initio* and as if the USPTO had never issued the Office action.[1]

The USPTO appreciates that there may be situations in which it is appropriate to treat an Office action or notice issued in an application as void *ab initio* and as if the USPTO had never issued the Office action. However, these would be extremely rare situations, such as the issuance of an Office action or notice by an employee who does not have the authority to issue that type of Office action or notice, the issuance of an Office action or notice in the wrong application, or the issuance of an Office action or notice containing language not appropriate for inclusion in an official document. In essence, the situations in which it is appropriate to treat an Office action or notice issued in an application as void *ab initio* and as if the USPTO had never issued the Office action are the situations in which it is appropriate to expunge an Office action or notice from the USPTO's record of the application. That is simply **not** the case in this situation.

Pursuant to 35 U.S.C. § 154(b)(1)(A)(i)(II), applicants are entitled to day-to-day adjustment if the USPTO delays the issuance of a patent by failing to mail at least one of a notification under 35 U.S.C. 132 not later than fourteen months after the date on which the application fulfilled the requirements of 35 U.S.C. 371. The record of the above-identified application indisputably indicates that the USPTO mailed a notification under 35 U.S.C. 132 in the form of a Restriction Requirement on January 15, 2008, fourteen months and 169 days after the date on which the application fulfilled the requirements of 35 U.S.C. 371, July 31, 2007. The fact that the Office later set aside the Restriction Requirement of January 15, 2008, does not negate the fact that the Office acted and mailed a notification under 35 U.S.C. 132 on January 15, 2008, within the meaning of 35 U.S.C. § 154(b)(1)(A)(i)(II) and 37 CFR 1.702(a)(1).

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[1] The Office notes that the Supervisory Patent Examiner was without authority to make a determination that the Restriction Requirements should not be used to calculate Patent Term Adjustment.

Unless expunged from the record (which is not warranted in this situation), for purposes of calculating patent term adjustment, the Restriction Requirement entered by the examiner on January 15, 2008, was properly used to determine whether the USPTO

delayed the issuance of a patent by failing to mail at least one of a notification under 35 U.S.C. 132 not later than fourteen months after the date on which the application fulfilled the requirements of 35 U.S.C. 371 pursuant to 35 U.S.C. § 154(b)(1)(A)(i)(II) and 37 CFR 1.702(a)(1). *See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term*, 65 *Fed. Reg.* 54366 (Sept. 18, 2000) (final rule).

Similarly, unless expunged from the record (which is not warranted in this situation), for purposes of calculating patent term adjustment, the Restriction Requirements entered by the examiner on January 15, 2008 and December 10, 2008 were properly used to determine the period of time during which applicants failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application.

In view thereof, no change in the initial determination of patent term adjustment is merited. The patent term adjustment at the time of the mailing of the notice of allowance remains 43 days.

The Office acknowledges the $200.00 fee set forth in 37 CFR 1.18(e).

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicant will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicant approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3211.

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